

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed September 16, 2003. Claims 1-19 were rejected. The specification has been amended to address the concerns raised by the Examiner.

Claims 1-19 were originally presented. Claims 1-19 remain in the application.

Claim Rejections - 35 U.S.C. § 103

Claims 1-19 (including independent claims 1, 9, and 13) were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeLorme et al. (US 5,948,040) (hereinafter referred to as 'DeLorme') in view of McMahon et al. (US 5,789,732) (hereinafter referred to as 'McMahon'). The Office Action states that it would have been obvious, at the time the invention was made, to modify the teachings of DeLorme with the teachings of McMahon.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the present invention, there is no motivation or suggestion to combine the computerized travel system of DeLorme, and the optical communication of a bar code to a bar-code scanner of McMahon. In fact, the references teach away from the present invention because DeLorme teaches that downloaded tickets must be printed. This leads one to believe that a ticket must be printed and handed to a ticket taker in the traditional way. Specifically, DeLorme states that an object of the invention is to provide software so that documents may be printed, e.g. laser printed on perforated sheets of cardstock. (See Col. 7 Lines 2-6).

While DeLorme discusses the use of PDAs and other handheld computers (see Col. 10 Lines 12-18), the PDA is referenced only to be used separately from any purchased and printed tickets, for example as a guide during travel (see Col 10 Lines 47-51). DeLorme even discusses using laser printed bar coding (see Col 8 Lines 55-62), but fails to disclose any use of a PDA or other handheld computer used to optically transmit these bar codes. DeLorme does not suggest or teach, implicitly or explicitly, to use the PDA or handheld computer to display an optically readable ticket.

McMahon, on the other hand, only discusses the use of a handheld computer for two uses: (1) use of the device in real-time rain check generation in a store (see Col 2 Lines 28-31); and (2) use of the device in issuance of coupons from a kiosk system at the store (see Col 3 Lines 38-57). The device in McMahon is designed to only be used in a closed environment, such as a grocery or department store. Therefore, the device isn't designed to connect to a home computer and download purchased tickets or be taken out of a store. No where in McMahon is such a use disclosed. There is no explicit or implicit teaching or suggestion to use the device in such a manner.

Furthermore, the Office Action has stated in his rejection that one of ordinary skill in the art would have readily recognized substituting the teachings of McMahon into DeLorme. The Federal Circuit has affirmed that simply concluding modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art **is not sufficient to establish a prima facie case of obviousness** without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The Office Action has not shown that there is some objective reason for combining the references outside of what was taught by the specification of the present invention. The specification of the present invention taught that use of an optically communicated electronic ticket would eliminate the need for carrying paper tickets (as pointed out by the Office Action). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, there is no motivation to combine the two patents. The Examiner is relying on hindsight, having knowledge of the applicant's own structure. But for this knowledge, the combination of references would not have occurred to the Examiner, as it did not occur to those skilled in the art to make the asserted combination. The cited patents were filed nearly seven years ago. In an area where technological change is happening at a rapid pace, if such an invention were obvious it would have been combined shortly after the publication of these patents.

Therefore, Applicant respectfully submits that claims 1-19 are allowable, and urges the Examiner to withdraw the rejection.

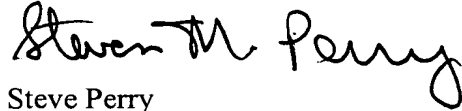
CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1-19 are now in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Steve Perry at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 5th day of December, 2003.

Respectfully submitted,

A handwritten signature in black ink that reads "Steven M. Perry". The signature is written in a cursive style with a large, stylized "P" at the end.

Steve Perry

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